

REMARKS**Claim Status**

Claims 1-34 are pending in the application. Claims 17-20 have been withdrawn from consideration. This paper amends claim 21, 27, and 28. Claims 1 and 21 are the independent claims of the application that have not been withdrawn from consideration.

Note Regarding Disposition of Claims

The Office Action Summary indicated that claims 1-16 and 21-34 are pending in the application. Applicants note that claims 17-20 have been withdrawn from consideration, but are still pending. The Office Action indicated that the withdrawn claims have been rejected. Applicants understand this indication to be a clerical error. If the rejections of claims 17-20 were in fact intended, Applicants respectfully traverse the rejection.

Art Rejections

The Office Action rejected claims 1, 3, 7-16, 21, and 26-34 under 35 U.S.C. § 103(a) as being unpatentable over Diwan, U.S. Patent Number 6,801,936 (“Diwan” hereinafter) in view of Sahai *et al.*, U.S. Patent Number 6,594,699 (“Sahai” hereinafter). The Office Action further rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Diwan in view of Sahai and in further

view of Katariya *et al.*, U.S. Patent Publication Number 2002/0091789 (“Katariya”). Claims 4-6 and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Diwan in view of Sahai and further in view of Feinleib, U.S. Patent Number 6,272,532 (Feinleib”). Applicants respectfully request reconsideration based on the above amendments and the following arguments.

Claims 1 and 21

In rejecting independent claims 1 and 21, the Office Action acknowledged that Diwan does not explicitly disclose “structured document customized according to capabilities of and for delivery to said Internet appliance.” The Office Action then sought to supplement this admitted deficiency in Diwan with the disclosure of Sahai.

There are three basic requirements for establishing a *prima facie* case of obviousness. MPEP § 2143. First, the combination of prior art references must teach or suggest all the claim limitations. *Id.* Second, there must be a reasonable expectation of success. *Id.* Third, there also “must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings.” *Id.* Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Here, the references do not teach or suggest all the limitations of the claims, and do not contain a suggestion to combine or modify the references’ teachings.

The Office Action asserted that Diwan discloses identifying information units in structured documents, at column 1, lines 25-30 and 35-40; at column 2, lines 4-7 and 48-52; and at column 3,

lines 15-18 and 30-33. The Office Action further asserted that Diwan discloses selecting one or more of said information units for delivery, at column 5, lines 31-34 and 50-59; and at column 5, line 66, through column 6, line 5. It appears that the Office Action equated the information in the multiple information sources received by Diwan's system with a "structured document" of claim 1. These, however, are different concepts.

Diwan's system "gathers information from multiple information sources (145-155), packages at least some of the gathered information into customized bundles according to the received requests and the stored rules, and delivers the customized bundles to the subscribers (105-125) according to the stored rules." Diwan, the Abstract. The information in the bundles is received from multiple, different sources. In contrast, in computer science the noun *document* signifies "a computer file" Hyperdictionary, available online at <http://www.hyperdictionary.com/computer>.¹ Even if Diwan's system receives "documents" from the multiple information providers, the selection of such purported documents for the customized bundles and individual subscribers is not the same as selection of information units in a structured document.

The application specifies that "[a]ccording to the present invention, web content is treated as structured documents consisting of inter-related 'information units.'" Specification, at page 7, lines 30-32. Note that "web" (as in "world wide web") is generally understood to be a "computer network consisting of a collection of internet sites that offer text and graphics and sound and animation resources through the hypertext transfer protocol." Hyperdictionary, available online at <http://www.hyperdictionary.com/computer>. Thus, the concept of the "web" is not the same as the

¹ Such computer file may include other files embedded or otherwise referenced in it, as is described in more detail in

concept of the “Internet”; the Internet is not limited to hypertext transfer protocol. Broadcast or a multicast messages from the multiple information providers in Diwan are not (or at least are not necessarily) “web content.” Therefore, these messages are not “structured documents” with information units, as recited in the claims.

Note further that independent claim 21 has been amended to recite, *inter alia*, “web pages” and “said document customization service identifying information units in said web pages and enabling the user to select one or more of said information units for delivery to the user.” Support for these limitations may be found in the specification, for example, at page 3, lines 2-4 and 12-14. Diwan does not teach *identifying information units in said web pages and enabling the user to select one or more of said information units for delivery to the user*.

Turning next to the purported motivation to combine Diwan and Sahai, the Office Action gave the following motivation for combining these references: “for the user to view multimedia streams.” No source of this purported motivation has been cited.

Diwan’s customized bundles are delivered using multicast techniques. *E.g.*, col. 1, lines 47-52. If a customized bundle includes a multimedia stream, it may be viewed at the user’s device regardless of being customized in accordance with the capabilities of the user’s device, even if the viewing is not specifically tailored to the user’s device. Customizing would not enable viewing a multimedia stream if the user’s device is not adapted for viewing. If the customized bundle does not include a multimedia stream, then the rationale for combining the references offered in the Office Action simply does not apply. Thus, multimedia streams may or may not be viewable at the user’s

the application.

device regardless of customization. The rationale for combining the references given in the Office Action – “for the user to view multimedia streams” – does not explain why a person skilled in the art would have been motivated to import Sahai’s teaching into Diwan’s system.

Applicants respectfully submit that independent claims 1 and 21 are patentable over Diwan and Sahai at least for these reasons.

Claim 7

In rejecting dependent claim 7, the Office Action asserted that Diwan discloses “specifying said structured document from by a uniform resource locator (URL),” at column 2, lines 46-47 and 59-61; and at column 3, lines 8-11. The undersigned attorney has reviewed Diwan, and the cited text in particular, but has not been able to identify a disclosure or a suggestion of specifying a structured document by a URL. Indeed, an electronic search of the Diwan document has not turned up any occurrences of “URL” or “uniform resource locator.” It appears that there is no such disclosure or suggestion in Diwan. At least for this reason, Applicants respectfully submit that claim 7 is separately patentable over the references.

Claim 8

In rejecting dependent claim 8, the Office Action asserted that Diwan discloses selecting said structured document from a list of bookmarks, prior to the identifying. In particular, the Office

Action cited Diwan at column 3, lines 47-50; and at column 5, lines 27-30. The undersigned attorney has reviewed Diwan, and the cited text in particular, but has not been able to identify a disclosure or a suggestion of specifying a structured document from a list of bookmarks. An electronic search of the Diwqan document has not turned up any occurrences of the word “bookmark.” It appears that there is no such disclosure or suggestion in Diwan. At least for this reason, Applicants respectfully submit that claim 8 is separately patentable over the references.

Claim 9

In rejecting dependent claim 9, the Office Action asserted that Diwan discloses the Internet appliance including a means for determining the appliance’s geographical location. In particular, the Office Action cited column 4, lines 52-60. For convenience, the cited text is quoted below:

The requests field 314 may store information that indicates the types of information that the subscriber(s) identified in the corresponding subscriber identifier field 312 desires. The requests field 314 may include, for example, requests for stock quotes, current weather conditions, sports scores, news headlines, etc. The requests may be general or specific in nature. For example, a subscriber might request stock quotes for GTE stock, weather conditions for Boston, NBA scores, and all news headlines concerning Fortune 500 companies.

Diwan, col. 4, lines 51-60. This text makes clear that it is the subscriber who specifies the geographical location pertaining to the information (weather, NBA scores). The subscriber’s device does not necessarily include means for determining the geographical location. In fact, the subscriber and the device may be located in a place other than the specified place. For example, a subscriber in California may specify Boston because he or she is a fan of a Boston NBA team, or may contemplate traveling to Boston and consequently be interested in Boston’s weather.

It appears that Diwan does not disclose or suggest means for determining the internet appliance's geographical location. At least for this reason, Applicants respectfully submit that claim 9 is separately patentable over the references.

Dependent Claims

Dependent claims not specifically addressed above should be patentable at least for the same reasons as discussed above in relation to their base claims and intervening claims, if any.

CONCLUSION

For the foregoing reasons, Applicants respectfully submit that all pending claims are patentable over the references of record. To discuss any matter pertaining to the present application, the Examiner is invited to call the undersigned attorney at (858) 720-9431.

Having made an effort to bring the application in condition for allowance, a timely notice to this effect is earnestly solicited.

Respectfully submitted,



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